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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,055	04/02/2004	Yves R. Hoarau	HOARAU-01	2228
7590		01/30/2006		
John M. Macaulay 2324 Temple Drive Davis, CA 95616			EXAMINER STOKES, CANDICE CAPRI	
			ART UNIT	PAPER NUMBER
			3732	
DATE MAILED: 01/30/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/817,055	Applicant(s) HOARAU ET AL.	
	Examiner Candice C. Stokes	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/02/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/02/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,4,6-8,10,14-20,23, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnes et al (USPN 6,575,908). Barnes et al disclose an intraoral data input tool 100, said tool comprising: a handle 114, and a head 118 attached to a first end of said handle 114, said head 118 including a data input device 100, said data input device 100 being responsive to force applied by a stylus 122, said head 118 being configured to allow a dental examiner to input data using said stylus on said input device when said head is positioned at least partially within said patient's mouth. This also anticipates Claim 16. As to Claim 4, the data input device 110 comprises a multiplicity of push buttons 128,132,134. Regarding Claims 6-8, the data input device 110 comprises a touch sensitive display 110 (see column 4, lines 43-47); the screen 110 acts as a mirror; and the multiplicity of push buttons 128,132,134 are located peripherally about said mirror. With respect to Claim 10, the screen 110 is also considered a display. As to Claim 14, the tool 100 further comprises an electrical connector 210 (as shown in Figure 2) attached to a second end of said handle 114, and an electrical cable 212 connecting said electrical connector 210 to said data input device 110. Regarding Claims 15 and 17, the stylus 122 is capable of functioning as a dental probe. As to Claim 18, the system 100 further comprises a controller 214

Art Unit: 3732

with an operating program, said controller 214 being linked to said intraoral data input tool 110 by a communication means. Regarding Claim 19, the communication means comprises an electrical cable as shown in Figure 2 hanging from the bottom of the device 100. Barnes et al also disclose a dental data input system 100 wherein said communication means is a wireless communication means 123. To Claims 23 and 25, the dental input system 100 comprises a display 110 electrically connected to the controller 214; and a keyboard or auxiliary input device 128,132,134 electrically connected to the controller 214. Inherently there is some sort of operating program within this device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1) Claims 2-3,5,9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes et al. Barnes et al disclose the claimed invention except for the discoid head. It would have been an obvious matter of design choice to manufacture the head of the device having a discoid shape, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art.

As to Claim 5, Barnes et al disclose the claimed invention except for the buttons being sized in the range of 1 to 2 square millimeters. It would have been an obvious matter of design choice to manufacture the head of the device having a size within this range, since such a

Art Unit: 3732

modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Further regarding Claim 13, Barnes et al disclose the claimed invention except for the wireless communication device being within the handle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to enclose the wireless communication device within the handle, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

2) Claims 11-12 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes et al in view of Jung et al (US 2003/0156283). Barnes et al disclose the claimed invention except for the translucent disposable cover and dental operating programs. Jung et al disclose the use of a translucent cover 50 to protect the device. Further Jung et al teach a dental operating program as shown in Figures 9A and 9B. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the disposable cover and dental operating program as taught by Jung et al into the device of Barnes et al in order to protect the device from dust or other foreign particles when not in use and the dental program or any program could be adapted into any device that holds or reads data.

Regarding Claim 12, Barnes et al discloses a clamp 116 which could be used to hold a cover onto the device to prevent it from easily slipping off.

3) Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes et al in view of Mattson et al (USPN 5,303,148). Barnes et al disclose the claimed invention except for the voice synthesizer. Mattson et al teach a voice synthesizer which "audibilizes text or word

Art Unit: 3732

information, as well as word information components to machine signals, in language designated by the language code" (column 5, lines 17-22). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the voice synthesizer as taught by Mattson et al into the device disclose by Barnes et al in order to provide an additional auxiliary feature that allows the operator to input information without the use of the buttons or stylus.

Conclusion

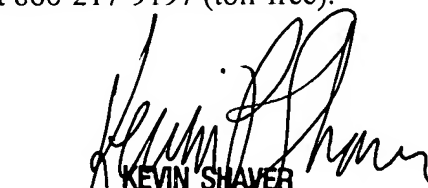
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Candice C. Stokes whose telephone number is (571) 272-4714. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Candice C. Stokes



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